

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor: GLARE et al.

) Group Art Unit: 1638

Serial Number: 10/070,489

) Examiner: Anne R. Kubelik

Filing Date: September 17, 2002

)

Title Nucleotide Sequences Encoding an Insecticidal Protein Complex from Serratia

Express Mail No. EL 993 687 252US

Mailing Date: November 15, 2004

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to an Office Action mailed on September 14, 2004, in connection with the above-identified patent application, setting a one-month term for filing of a response. Applicants were requested to restrict the present application to one of the following inventions:

Group I, claims 1-14, 16, 41-43 drawn to a nucleic acid, vectors comprising the nucleic acid, a method of using it to produce a protein, and a plant, bacterium, virus or fungus comprising it.

Group II, claims 15, 21-40, and 44-48, drawn to a polypeptide with insecticidal activity, a composition comprising it and a method of using it to combat pests.

Group III, claims 17-18, drawn to a ligand.

Group IV, claims 19-20, drawn to probes and primers.

According to the Examiner, the inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1, because under PCT Rule 13.2, they fail to share a special technical feature.

Applicants respectfully traverse the Examiner's restriction requirement for the following reasons. Applicants submit that the Group I and Group IV, at the minimum, should be combined since probes and primers in Group IV are also fragments of the nucleic acid recited in claim 1 of Group I. Because the inventions of Group I are nucleic acids and the probes and primers of Group IV are also nucleic acids, the inventions of Groups I and IV share the same technical feature in that they are both nucleic acids and form a single general inventive concept.

In addition, Applicants respectfully submit that Group II and Group III, at the minimum, should also be combined since the claims of Group II are drawn to polypeptides, and Group III are drawn to a ligand that may be an antibody or antibody binding fragment that are also proteins. Therefore, the inventions of Groups II and III share the same technical feature in that they are both polypeptides and form a single general inventive concept.

Applicants note that if the Examiner wishes to maintain the restriction requirement, it is incumbent on the Examiner to show that the claimed inventions are capable of supporting separate patents and that nucleic acids among themselves fail to share a special technical feature. Applicants respectfully request that this restriction requirement be withdrawn.

However, in the interest of expediting prosecution, Applicants hereby elect for examination the claims in Group I (claims 1 - 14, 16, and 41 - 43), with traverse as between Groups I-IV. Applicants reserve the right to re-present non-elected claims of Groups II-IV in a divisional application.

On page 2 of the Office Action, the Examiner alleges that the technical feature linking the groups is a nucleic acid encoding an insecticidal protein complex or portion of it and that this technical feature is taught by Grkovic et al., Nunez-Valdez et al., and Bowen et al. In particular, the Examiner alleges that the nucleic acid taught by Grkovic et al., Nunez-Valdez et al. and Bowen et al. would each have 75% homology with SEQ ID NO:1 and would hybridize to it under stringent hybridization conditions.

The Examiner therefore concludes that claim 1, among others, is not novel and the technical feature linking the groups is not special. Applicants respectfully traverse this objection because the references cited by the Examiner do not teach or disclose SEQ ID NO:1.

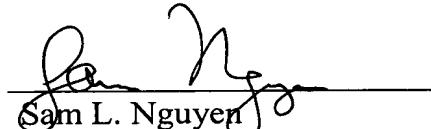
Grkovic et al., 1995, reported on incomplete plasmid clones and did not publish any sequence data, much less the data of SEQ ID NO:1. And with respect to the objections over Nunez-Valdez et al. and Bowen et al., Applicants respectfully request the sequence alignment between SEQ ID NO:1 and the Nunez-Valdez et al. and Bowen et al. sequences for a determination of degree of homology as noted by the Examiner.

Withdrawal of the restriction requirement is therefore respectfully requested, and examination and allowance of the claims are respectfully requested.

The Commissioner is authorized to charge any fees, including any fees or credit any overpayment to Deposit Account No. 08-1641 (Attorney's Docket No. 24747-1104US).

Respectfully submitted,

Date: November 15, 2004



Sam L. Nguyen
Reg. No. 52,496

HELLER EHRLICH WHITE & McAULIFFE LLP
Customer No. 25213
275 Middlefield Road
Menlo Park, California 94025
Telephone: (650) 324-7000
Facsimile: (650) 324-0638

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